



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/653,523	09/02/2003	Paolo Tiramani	286357-00004-1	3343
7590	01/21/2010		EXAMINER	
David C. Jenkins			CHAPMAN, JEANETTE E	
Eckert Seamans Cherin & Mellot, LLC				
44th Floor			ART UNIT	PAPER NUMBER
600 Grant Street				3633
Pittsburgh, PA 15219				
			MAIL DATE	DELIVERY MODE
			01/21/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/653,523

Filing Date: September 02, 2003

Appellant(s): TIRAMANI, PAOLO

David C. Jenkins
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 21, 2009 appealing from the Office action mailed December 24, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

3,712,007	KUMP	1-1973
2,644,203	DONAHUE	7-1953

2,070,924	DERMAN	2-1937
4,779,514	PRIGMORE ET AL	10-1988

APPENDIX 2 - EVIDENCE APPENDIX

Exhibit A - definition of "frame", The Handcock Joist, Joist And Structural Glossary, submitted on February 24, 2009, in response to the Final Office Action of December 24, 2008.

Exhibit B - definition of "frame", Contractor Glossary of Terms, submitted on February 24, 2009, in response to the Final Office Action of December 24, 2008.

Exhibit C - definition of "frame", Encarta, submitted on February 24, 2009, in response to the Final Office Action of December 24, 2008.

Exhibit D - definition of "frame", Merriam-Webster Online Dictionary, submitted on February 24, 2009, in response to the Final Office Action of December 24, 2008.

Exhibit E - definition of "frame", The American Heritage® Dictionary of the English Language: Fourth Edition, 2000, submitted on February 24, 2009, in response to the Final Office Action of December 24, 2008.

Exhibit F - definition of "stud", Affidavit of Robert Delorenzo, submitted on September 17, 2008, in response to the Office Action of June 24, 2008.

Exhibit G - definition of "stud", Guertin and Arnold, Fine Homebuilding, "Anatomy of a Stud-Framed Wall," at <http://www.taunton.com/finehomebuilding/pages/h00023.asp>., submitted on September 17, 2008, in response to the Office Action of June 24, 2008.

Exhibit H - definition of "studs", Ask This Old House, Stud Spacing, <http://www.thisoldhouse.com>, submitted on September 17, 2008, in response to the Office Action of June 24, 2008.

Exhibit I - definition of "studs", Ching, Building Construction Illustrated (3rd Ed.), 2001, page 5.03, submitted on September 17, 2008, in response to the Office Action of June 24, 2008.

Exhibit J - definition of "stud", The BOCA National Building Code, 1999, submitted on September 17, 2008, in response to the Office Action of June 24, 2008.

Exhibit K - definition of "post", Encarta., submitted on September 17, 2008, in response to the Office Action of June 24, 2008.

25

GLOSSARY OF JOIST AND STRUCTURAL TERMS – part of exhibit A submitted 2/24/09

A concrete pad or mat located under a column, wall, or other structural member that distributes loads from that member into the supporting soil.

Foundation

The substructure which supports a building or other structure.

Frame

A structural framing system consisting of members joined together with moment or rigid connections which maintain their original angular relationship under load without the

need for bracing in its plane. See Rigid Frame.

Framed Opening

Headers or other structural members which surround an opening in a roof which can be for mechanical units, strairwells, etc.

Framing Plan

Floor or roof plans that identify individual marks, components, and accessories furnished by the joist manufactures in a detailed manner to permit proper erection of the joist and joist girders. See Erection Plan and Placing Plan.

Free-Body Diagram

A diagram on which all of the external forces acting on a body are shown at their respective points of application.

Frequency

A measure of floor vibration. It is the speed of the oscillations of vibration and is expressed in cycles per second or Hz (Hertz).

G-Type Joist Girder

A type of Joist Girder where joists are located at panel points where diagonal webs intersect the top chord only.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13-15 depend on a cancelled claim 12

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2, 4, 9-11, 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kump(3712007) in view of Donahue.

Claim 1.

Kump discloses a prefabricated house comprising:
two or more modules 14, each module having a frame 11/12/42, said frame 42 having a plurality of studs(the horizontal and vertical portions of the frame);
said module frames having one or more multi-frame openings 41 (*and those in between elements11 and 12);
each said multi-frame 41opening incorporating two studs from said flame plurality of studs and having a plurality of medial cross-members 42/46(the medial or cross members being those in between the studs ; and
said two or more modules 14 structured to be joined at one of said one or more multi-frame openings. See column 4, lines 1-20.

Applicant argues that the base reference does not include studs making up the openings of/ between modules

Donahue discloses:

A prefabricated house comprising:
two or more modules 10/16, each module having a frame, said frame having a plurality of studs 70, 12,95, 99, figure 2;
said module frames having one or more multi-frame openings at 102/103;

each said multi-frame opening incorporating two studs 70/99 from said frame plurality of studs.

In view of the above, it would have been obvious to include the modules including studs and incorporating studs from the plurality of studs in order to reinforce and strengthen the modules. See figures 1, 4 and 6

claim 2.

Kump discloses the prefabricated house of claim 1 wherein:

said multi-frame openings 41* are enclosed within a covering 44 over said frame; and
said multi-frame openings are structured to be converted into openings.

claim 3.

(Cancelled)

claim 4.

Donahue discloses the prefabricated house of claim 1 wherein
each cross-member 46 in said plurality of cross-members, figure 6, is coupled to said
studs in a manner sufficient to support any additional components selected from the
group including: doors, windows, fireplaces or dormers. See motivation statement
above.

Claims 9-11:

Regarding claim 9: Kump discloses the multi-frame opening are structured to be converted into an openings such as doors 18.

Regarding claim 10: Kump discloses modules joined at multi-frame openings 41* with the modules disposed in more than one configuration relative to each other. See figure 1

Regarding claim 11: Kump discloses the multi frame opening s enclosed within a covering 44 over the frame 41* and the multi frame openings are structured to be converted into openings such as doors or windows 17, 18.

12. (Canceled)

Claim 13:

Kump discloses the prefabricated house of claim 12 wherein each cross member in a plurality of cross member 46 is coupled to the studs 42 in a manner sufficient capable of supporting any additional components selected form the group including doors , windows 18. See figure

Claim 17.

Kump discloses The prefabricated house of claim 1 wherein said modules 14 may be joined at said multi-frame openings 41* with said modules disposed in more than one configuration relative to each other. See figure 1.

Regarding claim 18: It would have been obvious to one of ordinary skill in the art to add any type of trim to provide a finished and completed appearance to the building structure

Claims 5-6 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kump in view of Donahue and further in view of Derman (2070924). Kump lacks the cross members removably coupled to the studs. Derman discloses a cuboid volume

with cross members 35/27 and studs 22/19. The studs are removably coupled to the cross members. It would have been obvious to one of ordinary skill in the art to removably couple the studs to the cross members to allow for a greater degree in variation of size of the opening for the modules modules as shown by Derman.

Claims 7-8, 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kump in view of Donahue and further in view of Prigmore et al (4779514).

Claim 7-8 and 19:

Prigmore et al includes a prefabricated unit with foldable panels. One of the modules is a core having a fixed spaced portion 16/18 and a passive space portion 12/14. The fixed spaced portion having non-foldable walls and the passive space portion having foldable panels. See figure 7 of Prigmore et al. the foldable panels are movable from a first closed position to a second open position. The size of the fixed space in comparison to the passive space has been considered a matter of choice. One of ordinary skill in the art would have appreciated making the modules of any dimensions permitting the intended use, function and purpose of the prefabricated unit. It would have been obvious to one of ordinary skill in the art to modify Kump to include foldable panels and the fixed and passive spaces to permit transport of the prefabricated unit as shown by Prigmore et al.

Regarding claim 16: It would have been obvious to one of ordinary skill in the art to add any type of trim to provide a finished and completed appearance to the building structure.

(10) Response to Argument

Claims 13-15; Rejected under 35 U.S.C. § 112, second paragraph

Appellant argues: "On February 24, 2009 Appellant filed a response after final that amended, *inter alia*, the dependencies of Claims 13 and 15 thereby removing this issue from a potential appeal. The Examiner refused to enter this amendment. The Examiner did not provide a reason for declining entry of the amendment as required by MPEP § 714.13. Appellant notes that, while the general rule is that an amendment should not be entered in part, MPEP § 714.20(C) provides that an amendment curing a formal defect may be entered in part. Thus, to the extent the Examiner was disinclined to enter the entire amendment, the Examiner could have entered the portion of the February 24, 2009 amendment curing this issue. In any event, Appellant believes this issue may be cured after the decision on this Appeal."

In response: The examiner did give a reason and that reason being that the amendment changed the scope of the invention by adding the "module" before the word "multi-frame" see the advisory action dated 4/23/09 box 3c; Box 3c explains the reason for not entering the amendment being "they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal"; The underlined word added to claim 1 changed the scope and meaning of the claim and thus not materially reducing or simplifying the issues for appeal.

If applicant truly desired to correct the problem a separate amendment should have been filed addressing only the issue of claims 13-15 depending on a cancelled claim 12.

Claims 1-2, 4, 9-11, and 17-18; Rejected under 35 U.S.C. § 103(a)

Claims 1-2, 4, 9-11, and 17-18 are rejected under 35 U.S.C. § 103(a) as being

unpatentable over Kump (U.S. Patent No. 3,712,007) in view Donahue (U.S. Patent No. 2,644,203).

Appellant argues, ".....Appellant initially notes that, while the claims must be given their broadest reasonable interpretation, such an interpretation must be reasonable, "in light of the specification as it would be interpreted by one of ordinary skill in the art. "In re Am. Acad. Of Sci. Tech. Ctr., 367 F.3d 1359, 1364, 70 USPQ2d 1827 (Fed. Cir. 2004) (emphasis added)."

Applicant also argues, "Reference to "one skilled in the art" when determining the broadest reasonable interpretation is notable as general usage dictionaries do not always provide the definition used by skilled persons...where evidence such as expert testimony or technical dictionaries demonstrates that artisans would attach a special meaning to a claim term ... 'general-usage dictionaries are rendered irrelevant with respect to that term we have previously cautioned against the use of non-scientific dictionaries, 'lest dictionary definitions be converted into technical terms of art having legal, not linguistic significance.. The holding of such cases is very relevant to the discussion set forth below as, despite the fact that the Appellant has submitted evidence both from a neutral expert and definitions from technical dictionaries, the Examiner has consistently applied an overly broad interpretation to the words recited in the claims."

In response: All references deal with structure in the building structure art. The knowledge in this art is varied and expansive in nature. The expansive and varied nature should not infer that something not commonly employed or employed specifically in one piece of prior art reference should imply non-obviousness. From the examiner's

ten year knowledge in the art and form the knowledge of the prior art references and reasonable and broad interpretation of the claim language was given to properly evaluate and reject the claim.

Appellant states, "...The Kump disclosure was an attempt to overcome the "archaic" (Col. 1, line 19) building techniques of the 1970s. While history has shown that the "archaic" building techniques have hung on for nearly four decades after Kump, ... As Kump is a radical departure, it follows that the structures disclosed in Kump are substantially dissimilar from structures created by other construction techniques, including those techniques still in use today..."

In response: the above does not obviate the fact that Kump is still known in the art and read on a majority of the claimed elements. Further, the alleged missing element in the amended claims is the definition of beams versus post versus studs is the only supposed difference.

Appellant states, "It is noted that the Kump structural frame is designed to support the various modules as well as various other housing elements such as pipes and electrical conduits. ... The structural frame also supports the weight of the building and any lateral forces, e.g. wind load, applied thereto. ...this configuration, the modules are not structured to support the weight of the building, resist lateral loads, etc. Accordingly, each module must only support its own weight and the weight of any internal loads. Thus, Kump discloses that each module...is a hollow cube-shaped enclosure having rounded outer walls. ... The composite assembly has structural strength and also provides thermal and sound insulation... Thus, the "module frame," as opposed to the

"structural frame," disclosed in Kump is the shell/walls that form the module. ... Thus, Kump discloses three types of frames; (1) a structural frame, (2) a module frame, and (3) opening frames.

In response: The last two sentences appear to be a contradiction; it is not clear as to what is being stated or the point being argued. Further, applicant' is arguing more limiting than what is claimed. The claims do not recite the three types of frames and neither do the claims make a distinction between the three

Appellant further states, "... the prefabricated house includes a plurality of modules each having a "frame." Thus, as used in this application a "frame" means the frame of the module. Moreover, given the description of studs and cross-members, it would be clear to one skilled in the art that the module frame of the present application is a traditional frame.

In response: The claims do not recited a traditional frame; further what is considered in the art to be traditional frame for modules.

Appellant argues:

".....the module frame is that structure that supports the walls and any upper floors. Further, while not stated specifically in the present specification, it would be understood by those skilled in the art that the module frame is also the structure that resists lateral loads.

In response: Appellant is correct the term module frame is broad in its most reasonable term; the claims do not limit the meaning of this term as applicant intended.

Appellant notes in secondary sources specific to the construction arts, a "frame" is defined as, "[f]rame: A structural framing system consisting of members joined together with moment or rigid connections which maintain their original angular relationship under load without the need for bracing in its plane." The Handcock Joist, Joist And Structural Glossary (Evidence Appendix, Exhibit A), and "[t]he skeleton of a building; that is, the rough structure of a building, including interior and exterior walls, floor, roof, and ceilings." Contractor Glossary of Terms (Evidence Appendix, Exhibit B). In other secondary sources not specific to the construction arts, a "frame" is defined as "... a structure that surrounds or encloses a particular space, • a picture frame, " a door frame..." Encarta (Evidence Appendix, Exhibit C); and, "the underlying constructional system or structure that gives shape or strength (as to a building)" Merriam-Webster Online Dictionary (Evidence Appendix, Exhibit D); and "[a] structure that gives shape or support: the frame of a house," The American Heritage® Dictionary of the English Language: Fourth Edition, 2000 (Evidence Appendix, Exhibit E). Thus, in the present application, the frame is that system/structure that encloses the module or gives shape and support to the module. Conversely, in Kump that system/structure that encloses an "opening," such as a door, would be described as a "door frame."

In response: Kump meets at least two of the definitions of frame. Kump discloses the skeleton of a building; that is, the rough structure of a building, including interior and exterior walls, floor, roof, and ceilings. Kump discloses... a structure that surrounds or encloses a particular space; Kump also discloses an underlying constructional system

or structure that gives shape or strength: Kump also discloses a structure that gives shape or support: the frame of a house."

appellant further states, "..... the various frames disclosed in Kump, the frames that serve a purpose similar to the module frame recited in the present claims are the structural frame and the module frame.

In response

However, appellant does not give the specific structural elements that distinguish the three type of frame, structural, module and opening frames.

Appellant further argues:

The Kump structural frame, however, consists of "posts" (vertical members) and beams (horizontal members). As with the rejection based upon Dattner (U.S. Patent No. 3,720,022) in the Office Action, dated June 24, 2008, which also disclosed a structure comprised solely of posts and beams the Kump structural frame does not include "studs" as recited in the present claims.

That is, the Kump structural frame is, essentially, the same as Dattner which disclosed a "building construction in which a basic unit of twelve elements is fabricated into a rectangular parallelepiped to define a structurally rigid module requiring no additional structural members." Dattner Abstract, see also Kump Figures 6 and 8. Such a module is defined by only four lower horizontal members, four vertical members, and four upper horizontal members - and no additional structural members. It is noted that each of the four vertical members is located at a corner. That is, no vertical member in a module is disposed generally between two other vertical members."

In response: Donahue was cited to show the studs between and belonging to each module not the Dattner reference; Dattner was previously applied in an art rejection but no longer employed in the rejection of the claims. Thus, arguments regarding the Dattner reference is moot given this reference has no longer been applied against the claims.

Further, as stated in the office action dated 11/28/07 in the response section.

According to Webster's New World Dictionary, college addition:

The definition of "post" is "a piece of wood or metal, etc, usually long and square or cylindrical, set upright to support a building, sign, grate, etc. or pole...."

The definition of "stud" is "a column, pillar, post to prop or support."

As noted in applicant's pat argument the claims must be given their broadest reasonable interpretation; further appellant has not given in the specification or claims specific definitions between a beam, post or stud distinguishing properties specific to each. The definition of Webster is considered the broadest most reasonable interpretation. The lowest level of ordinary skill in the art would appreciate Websters definitions. The definition given in Evidence appendix B and the above prior art exhibits give other definitions known by other more experienced skilled artisians.

The definition given by the affidavit of Robert DeLorenzo is what has been considered as one of the building industry definitions. This declaration, however does not distinguish or highlight any claim language that distinguishes over the elements cited in the prior art neither does it influence the examiners interpretation of the term stud. The exhibit also do not further distinguish or influence the examiner to consider the claim

language over the prior art; these exhibit do not highlight any claim language that over the prior art mainly because they do not read over the broadest reasonable interpretation and accepted industry definition. Appellant merely gives his preferred interpretation. However , he is arguing more limiting than what is claim since the claim language does not recite his meaning of the term; further any definition of the term stud or post does not depend on the dimensions of the room/module as argued by the applicant.

Appellant further argues, “..... the present module frame is a traditional assembly of studs, cross-members, etc. while the Kump module is a uni-body, composite structure having no studs, headers, etc. Accordingly, this Kump modular frame is also not relevant to the present application.

In response:

Appellant has not given in his written specification disclosure neither the claims the specific definitions of post and stud considered to distinguish his combined his claimed structure over the prior art. Neither has appellant stated what is meant by traditional; there are many traditional structures in the prior art.

Appellant also states:

“The final Kump frame is the opening frame cited by the Examiner. As set forth above, the opening frame does not provide any structural support and does not act as a frame for the "module." As such, Appellant disagrees with the Examiner that Kump discloses a "module having a frame 42." December 24, 2008 Final Office Action at 2. Appellant

believes a more accurate description would be that Kump discloses a "module having an opening frame 42." Such a disclosure could be relevant if the present application recited, "a module having a door frame," but, as the frame recited in the present claims is the module frame, Appellant believes that Kump fails to disclose the elements as recited in the present claims."

In response: applicant is arguing more limiting than what is being claimed
applicant has not clearly defined in the claims specifically what he considers to be the distinguishing structure of a **module** frame; applicant has not defined his definition of a **module** frame; the broadest reasonable interpretations is a frame that fits around or within a module using any one of the frame definitions given above;

Appellant states

Donahue discloses a modular add-on bathroom for "a building, such as a rural residence, not previously having a bathroom." Col. 1, lines 4-5. That is, the modular room is structured to be attached to a preexisting home and, more specifically, to a home having traditional construction. The modular portion defines a room having a floor, three complete walls, one partial wall, a ceiling/roof and various bathroom fixtures with connective hardware. The three complete walls define the outer walls of the modular addition. The partial wall consists of an inner sheet disposed over a plurality of studs having a head plate and a shoe plate (top and bottom horizontal members) and may include intermediate horizontal brace members..."

In response: the examiner appreciates appellant's piecemeal analysis of the reference; Donahue was disclosed merely to show the studs/post, vertical/ horizontal between and

of the modules the main module and the add on bathroom. Again, the broadest and reasonable interpretation of the term stud, post and frame are given and employed.

Appellant argues: Thus, as Kump fails to disclose any "studs" and "a plurality of medial cross-members" between studs, it is impossible for Kump to disclose a "multi-frame opening" as a "multi-frame opening" is defined in this application.

In response: Kump and Donahue with the reasonable and broadest interpretation provide studs and medial cross members; see art rejection above. Again, appellant has not specifically defined or recited any distinguishing elements defining his cross members and multi frame openings over the prior art.

Appellant further argues

With regard to the determination of obviousness under 35 U.S.C. § 103, the Supreme Court has stated that:

Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely on building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

In addition, the Supreme Court also noted that:

Often, it will be necessary for a court to look to interrelated teachings of multiple

patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinnings to support the legal conclusion of obviousness"

In Response Again the references come from the building industry. Who can limit or specifically define or articulate why or how an idea may arise one can merely articulate why an idea may arise by giving a motivation statement as to why; Any one motivation statement for doing any one thing does not limit other motivations for doing the same thing; meaning there may be more than one motivation reason for doing any one thing. Appellant appear to be attacking the examiner's motivation for combining references which is different and variant form applicants. Applicant appear to be suggesting that different motivations provided in the art rejection above are not credible because they do not arise out of the same motivation as that of applicants

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the references were taken from the building industry art and they all concerned themselves with modular structures.

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Appellant also argues:

"The Examiner has not properly supported the rejection under 35 U.S.C. 9 103(a) and under KSR International. In the final Office Action, the Examiner has merely identified a list of elements recited in the present application and located various references wherein similar elements are disclosed. The Examiner has not "made explicit" the reason such references would, or could, be combined as suggested. That is on pages 2-3 of the December 24, 2008 Final Office Action, the Examiner recites a number of elements allegedly (see above) disclosed in the two references. The Examiner then states, "[i]n view of the above, it would have been obvious to include the modules including studs and incorporating studs from the plurality of studs in order to reinforce and strengthen the modules." This single sentence is the only explanation for the proposed combination.

In response to the above:

Appellant is appearing to instruct the examiner on the type of motivation to be provided such that the applicant may agree with the examiner's findings. The examiner has articulated his reason for combining references which was different from that of appellants reason for providing the assembly; however the appellant merely does not agree. Disagreement is not a basis for non-obviousness

Appellant further argues

Appellant believes that one skilled in the art would not attempt to combine these references as the underlying technology is too different. Moreover, given that Kump includes a structural frame that is sufficient to support the modular frame, there would be no reason to include additional studs, as in the Donahue frame. That is, studs would not add any structural benefit, but would add to the weight and cost of the overall structure.

IN response: this is applicant's interpretation of the facts. To further strengthen the internal structure one of ordinary skill in the art would have been motivated when needed to add studs particularly to the modules on the lower level to sustain those above.

Claims 5-6 and 14-15; Rejected under 35 U.S.C. § 103(a)

Claims 5-6 and 14-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kump (U.S. Patent No. 3,712,007) in view of Donahue (U.S. Patent No. 2,644,203) and further in view of Derman (U.S. Patent No. 2,070,924).

Appellant argues:

"The deficiencies of Kump and Donahue, and the reasons they cannot be combined, are noted above. Derman discloses a wardrobe or cabinet. There are at least three problems with the use of Derman as prior art: (1) Derman is non-analogous art; (2) the Derman reference fails to disclose the elements cited by the Examiner; and (3) the rejection is not properly supported.

In response:

(1) Derman discloses a building industry assembly of the traditional combined commonly employed with building elements; (2) the derman reference discloses the separate vertical and horizontal studs or the cross members and studs; (3) the rejection is supported by the proper motivation statement; to allow for variation in the size of the opening.

Claims 7-8, 16 and 19; Rejected under 35 U.S.C. § 103(a)

Claims 7-8, 16 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kump (U.S. Patent No. 3,712,007) in view of Donahue (U.S. Patent No. 2,644,203) and further in view of Prigmore et al. (U.S. Patent No. 4,779,514).

Appellant argues, "Prigmore discloses a building constructed of pre-made panels that are coupled together by hinges. There are at least two problems with the use of Kump in view of Prigmore as combined prior art: (1) Prigmore fails to disclose the elements cited by the Examiner; and (2) the rejection is not properly supported."

In response:

- (1) The elements are clearly specified by the examiner in the rejection above
- (2) The rejection is properly supported by the motivation statement and that being to permit/ facilitate transportation of the module.

Appellant further argues:

Each side panel of Prigmore is disclosed as being pivotally coupled to the roof structure by a hinge element and coupled to a floor element by a plurality of latches. Such a

configuration allows the structure to be moved in a collapsed form. The Examiner states that Prigmore discloses both "passive space" and "fixed space." Appellant disagrees. These phrases are defined phrases in the present application. At page 8, lines 19-31, the specification states:

fixed space is rigid and does not include foldable panels 18. Fixed space is typically any space that has functionality beyond providing volume.

In response:

The claims do not recite or define any distinguishing structure for the passive and fixed space. The mere mention of the terms does not define the supposed and alleged structural element s defining the fixed and passive spaces

Regarding the Declaration of Robert DeLorenzo: the affidavit does not address the prior art nor does it describe how the claims distinguish over the prior art. See response to the Declaration above also.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/JEANETTE CHAPMAN/
PRIMARY EXAMINER
ART UNIT 3633

Conferees:

Application/Control Number: 10/653,523
Art Unit: 3633

Page 25

/DAVID DUNN/

Supervisory Patent Examiner, Art Unit 3636

/Heather Shackelford/

Conferee